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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,064	01/31/2001	Barrett Richard Bobsein	A01157	1820

7590 08/27/2003

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EXAMINER
CHIN, PETER

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 20030801

Application Number: 09/774,064
Filing Date: January 31, 2001
Appellant(s): BOBSEIN ET AL.

Ronald D. Bakule
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 22,2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejected claims stand or fall together as stated in the brief.

(8) Claims Appealed

JP 3-340774	***Hoshino et al***	***7-1993***

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoshino et al (English translation provided).

Hoshino discloses a mixture of inorganic pigment and hollow emulsion polymer particles having bimodal particle size distribution. The diameter of the hollow polymer particle is between 0.3 and 5.0 micron or 300 and 5000 nanometers; the other smaller polymer particle is between 0.05 and 0.3 micron or 50 and 300 nanometers. The polymer particles are ideally present between 3 and 30% weight of the pigment (pages 6 and 7 of the translation) and thus, the inorganic pigment is between 97 and 70% by weight of the pigment. The examples show the claimed proportion and diameters of the two polymer particles. Page 6, last sentence of the translation discloses the choice of only 6 inorganic pigments among which is $CaCO_3$. The small number of choices would reasonably teach or infer the use of a single inorganic pigment species. Thus, Hoshino anticipates the claimed invention. At the very least, it would have been obvious to select a single species of inorganic pigment, $CaCO_3$ as an obvious matter choice depending

on availability and cost, and it would reduce the number of raw material thereby simplifying the process and product.

(11) Response to Argument

1. It is urged that Hoshino disclosure of such an "extreme" range of polymer emulsion particle, at least 1% of entire pigment amount coupled without an explicit disclosure of inorganic pigment component exclusively $CaCO_3$ would mitigate against the rejection of the claims under 35USC102(b) over Hoshino. The fact remains that the claimed range of polymer particles fall within the ambit of the preferred range in Hoshino as noted in the above rejection.

2. While Hoshino in the single example on page 11 employs 27 parts (27%) $CaCO_3$ it is in combination with 63 parts (63%)of kaolin clay to form the inorganic pigment portion of the pigment component of the coating composition. There are 10 parts (10%) polymer particles in the pigment portion. The disclosure of Hoshino is not limited to single example as implied by Appellant's argument. Selecting a single inorganic pigment, CaCO3 is taught by or at the least obvious over Hoshino as noted in the above rejection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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PC
August 21, 2003

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